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No. 74-584

Supreme Court, U. S.
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In the Supreme Court of the United States

OCTOBER TERM, 1974

MARY HELEN SEARS,
Petitioner,

v.

C. MARSHALL DANN, COMMISSIONER OF PATENTS

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Fourth Circuit

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REPLY MEMORANDUM FOR PETITIONER

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REPLY MEMORANDUM IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

Respondent has made no attempt to demonstrate that any of the reasons which warranted the grant of review in No. 74-450 is inapplicable to this case. Respondent concedes that 35 U.S.C. 122, which the court below has held to be embraced by exemption 3, is one of the "statutes that give government officials discretion to decide whether to disclose" adverted to in terms by the single question in No. 74-450 (Question 1 on this petition).[1]

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[1] See pages 1-7, numbered pars. (1), (2), (3), (6) and (7) of the pending "Petitioner's Motion for Summary Grant of Certiorari."

In its Reply Memorandum in No. 74-450 the government, responding to a suggestion that the case "only presents a question as

As predicted by petitioner's pending "motion" (p. 2) respondent, estopped from plausible argument germane to whether the writ should issue, prematurely contends, on the merits, that the decision below "is correct" (Opp. 4). Since in No. 74-450 review of the identical question was granted to permit a decision broadly definitive of exemption 3's application to "nearly 100 statutes" including § 122, this case should be considered on its merits concurrently with 74-450.[2]

Respondent's contentions, moreover, are demonstrably unsound.

Contrary to Opp. 4, the confidence provisions of § 122 are **not** restricted to "applications for patents". The

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to the applicability of section 1104 [49 U.S.C. 1104] to exemption 3" urged

> "But the *issue* presented in our petition *broadly* involves the scope of exemption 3 itself and not merely the particular confidentiality statute involved in this case.
>
> The question we are asking the Court to decide is whether exemption 3 applies to all specific nondisclosure statutes . . . If our view of exemption 3 is sustained . . . it will resolve the issue of its application to nearly 100 statutes. . . ." *including* specifically § 122. (Pet. in No. 74-450 p. 10, n.7).

Inconsistently, the government now asserts the "review" of this case, holding that § 122 is included within the secope of exemption 3, "will not assist this Court in its determination of the issue in Robertson" (Opp. 3) and implies that review should be denied because the "conflict among the circuits" is only as to "whether 49 U.S.C. 1504 and 42 U.S.C. 1306(a) are within the scope of exemption 3 (see Pet. No. 74-450, pp. 16-17); . . ." (Opp. 4).

But at page 17 of the petition in No. 74-450 the decision in *this Sears* case (Pet. in No. 74-450, App. E, pp. 23a-42a) is cited as evidencing the "uncertainty and confusion in the circuits", warranting review here.

[2] Petitioner stands ready to file a brief on the merits within 30 days of January 13, 1975 if the petition should be granted on that date, or within such shorter time as the Court may direct, so as to insure concurrent hearing with *Robertson* during the Spring of 1975.

statute provides broadly that "*no* information concerning the same" "shall . . . be given . . . " and hence blankets virtually the entirety of the Patent Office's documents.[3]

It accordingly cannot be fairly assumed that "the District of Columbia circuit would conclude" that 35 U.S.C. 122 "comes within exemption 3" (Opp. 4).

The conflict which in *fact* exists with the District of Columbia Circuit's rulings in *Robertson* and *Tax Analysts and Associates et al.* v. *Internal Revenue Service*, No. 73-1978, August 19, 1974 (Pet. App. E, pp. 33a-41a) is demonstrated at Pet. 20.

Nor is it fair to suggest that "the decision of the court of appeals here is correct under even the most restrictive reading of exemption 3" (Opp. 4).

The flat conflict with the Third and Fifth Circuits is demonstrated at Pet. 21 where it is also shown, implicitly, that statutes *like* 35 USC 122 which contain no express directions for the exercise of administrative discretion are deemed *outside* the exemption in those courts. Respondent has not even suggested a rationale, or a construction of these Third and Fifth Circuit cases, by which harmony with the decision below could be effected.

Respondent does not dispute the demonstration in Petitioner's pending motion (pp. 6-7, par. 7) that questions 2, 3 and 4 are fairly comprised within question 1 which this Court will in any event review in No. 74-450.

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[3] When the literal scope of § 122's confidence provisions which extend to all "information concerning" patent applications is appreciated, there is no basis for distinguishing, in the context of exemption 3, 49 USC 1504's reference to "information contained in any application, report or document filed [with the FAA] . . . or information obtained by the . . . [Federal Aviation] Administrator, pursuant to the provisions of this chapter," at issue in *Robertson*. *Cf.* Opp. 4, n. 6.

Thus, question 1 seeks an explication of exemption 3's application to all "statutes [including § 122] which give government officials discretion to decide whether to disclose."

Petitioner's question 3, *quoting* from § 122, illuminates one important consideration in determining whether § 122 qualifies under exemption 3, namely, are "abandoned [patent] applications"—the documents sought below—"'necessary to carry out the provisions of any Act of Congress' including 35 U.S.C. §§ 122 and 103 and hence disqualified from secrecy by the very terms of § 122?" [4]

Questions 2 and 4, in turn, are basic to any definition of what is required by the provisions of § 102 and 103 and hence, must be resolved in answering question 3.

For these reasons, respondent's further argument (Opp. 4-5) that "petitioner's other questions presented [i.e. 2-4]"—which respondent incorrectly summarizes at Opp. 4—are, in essence, hypothetical is simply incorrect, and *United States* v. *Richardson*, No. 72-885, decided June 25, 1974 is wholly irrelevant. These very questions, moreover, were raised by the original complaint (C.A. App.

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[4] The assertion that "legislative history set forth in the court of appeals' opinion (Pet. App. A, pp. 11a-15a) . . . shows that Congress intended Section 122 to include abandoned patent applications" is misleading. In fact, the only "legislative history" in the opinion appears in a single sentence as follows: "Both the House and Senate reports state that [s]ection 122 incorporates into the title the rule of secrecy of patent applications *which has existed in the Patent Office for generations.*' (Emphasis added.) H. Report No. 1923, 82d Cong., 2d Sess. at 7 (1952); S. Report No. 1979, 82d Cong., 2d Sess. at 6 (1952); U.S. Cong. & Admin. News, p. 2400". (Pet. App. A, 11a-12a). The balance of the cited passage deals with the question of whether abandoned applications were within that "rule of secrecy"—a controverted point on which the legislative history is silent.

I, p. 13) and squarely decided in each of the courts below and hence are now ripe for review here.[5]

Respectfully submitted,

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January 2, 1975

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[5] As the Fourth Circuit acknowledged (Pet. App. A, 8a-10a) *Kewanee Oil Co.* v. *Bicron Corp.*, 416 U.S. 470 (1974) did not raise or decide the questions presented in this petition, even though respondent (Opp. 5, n. 7) now appears to imply that it did. See Pet. p. 16-17.

The Fourth Circuit's rejection of petitioner's constitutional claims —which it misstated even as respondent has misstated them (Opp. 5, n. 7)—as "insubstantial" must be viewed in the light of that Court's failure to apply the strict test of insubstantiality laid down by this Court in *Goosby* v. *Osser*, 409 U.S. 512 (1973) and *Hagans* v. *Lavine*, 415 U.S. 528 (1974). See Pet. 15-18, including n. 21, p. 15, last par.